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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,558	02/26/2004	Jeffrey S. Haas	IL-11088	7059
7590	05/04/2006			EXAMINER SIEFKE, SAMUEL P
Eddie E. Scott Assistant Laboratory Counsel Lawrence Livermore National Laboratory P.O. Box 808, L-703 Livermore, CA 94551			ART UNIT 1743	PAPER NUMBER
DATE MAILED: 05/04/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/788,558	HAAS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Samuel P. Siefke	1743	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 25 and 26 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 3128/09, 2126/09
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, drawn to an explosive sample testing device, classified in class 422, subclass 58.
- II. Claims 25-26, drawn to a method for detecting explosive elements, classified in class 436, subclass 169.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by hand, i.e. swiping an object to obtain a test sample using a sample element by hand.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Eddie Scott on April 27, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 22-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kardish (USPN 5,648047).

Kardish teaches a hand-held device for rapid colorimetric detection of explosives, narcotics, and other chemicals which can be accurately operated by non-skilled personnel and perform numerous tests in a quick sequential manner without exposing a user to hazardous reagents and without exposing sensitive reagents to deteriorating environmental conditions, the device comprising (a) a housing for handling and using the device, the housing including a sampling area an a testing area; (b) a roll of substrate for sampling materials suspected as including the chemical; (b) a feeding reel being rotatably connected to the housing, the feeding reel being for accommodating the roll of substrate; (c) at least one container for accommodating at least one detecting reagent, the at least one detecting reagent is for the colorimetric detection of the chemical; and (d) at least one dispensing mechanism for dispensing a predetermined

volume of the at least one reagent onto the substrate at the testing area (abstract, see fig. 1, col. 5, lines 30- col. 6, lines 60).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-12,14-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kardish et al. (USPN 5,648,047) in view of Dietze et al. (USPN 5,035,862).

Kardish teaches a hand-held device for rapid colorimetric detection of explosives, narcotics, and other chemicals which can be accurately operated by non-skilled personnel and perform numerous tests in a quick sequential manner without exposing a user to hazardous reagents and without exposing sensitive reagents to deteriorating environmental conditions, the device comprising (a) a housing for handling and using the device, the housing including a sampling area an a testing area; (b) a roll of substrate for sampling materials suspected as including the chemical; (b) a feeding reel being rotatably connected to the housing, the feeding reel being for accommodating the roll of substrate; (c) at least one container for accommodating at least one detecting reagent, the at least one detecting reagent is for the colorimetric detection of the chemical; and (d) at least one dispensing mechanism for dispensing a predetermined volume of the at least one reagent onto the substrate at the testing area (abstract, see fig. 1, col. 5, lines 30- col. 6, lines 60). Kardish teaches the testing area can be made of paper, cloth (polyester material) or a synthetic membrane (col. 5, line 45). Each reagent container has individual dispensing mechanisms for delivering the reagent to the test area (col. 6, lines 8-35). Kardish states that the containers 28a and 28b are made of transparent and elastic properties. It is the Examiners position that an elastic container can be squeezed to expel the reagent to the sample substrate. The dispenser further comprises a check valve 41 at the end of the dispenser to prevent air from entering the containers.

Kardish does not teach providing a heater under the sample area and the reagent dispensers being positioned to move along the elongated body.

Dietze teaches a heater that is placed in thermal contact with a test strip in order to achieve rapid and selective heating of individual test fields on the test strip (abstract). It would have been obvious to one having an ordinary skill in the art at the time of the invention to modify Kardish to employ a heater that is below and in thermal contact with the test strip in order to provide rapid and selective heating of the sample on the test strip. It is well known in the art that adding heat to a reaction (sample and reagent) speeds up the reaction which is a desirable property to shorten the waiting time for the reaction product. Heating further increases the detection sensitivity (col. 1, lines 45-47).

Regarding claim 10, 12, 22 and 24 it would have been obvious to one having an ordinary skill in the art at the time of the invention to modify Kardish to employ a battery powered heater because the device is portable and would require an independent power source to provide energy to the heater. Batteries are well known in the art as a portable power supply in these types of devices.

Regarding the dryer, it would have been obvious to one having an ordinary skill in the art at the time of the invention to modify Kardish to employ a dryer on the sample substrate in order to dry the reaction product so that a colorimetric determination can be made. It is well known in the art as admitted by the instant specification that dryers are employed for this purpose.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 10/610,904 and claims 1-21 of copending Application No. 10/703,303. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both include a body (housing), a sample pad, a heater under the sample pad, and reagents that are dispensed from reagent containers to the sample pad to react with a sample. Therefore the instant claims fully encompass the claimed subject matter of Application No. 10/610,904 and 10/703,303.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel P. Siefke whose telephone number is 571-272-1262. The examiner can normally be reached on M-F 7:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sam P. Siefke



April 28, 2006